

JAN 24 2006

CERTIFICATION UNDER 37 CFR 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted on the date indicated below via facsimile to the United States Patent and Trademark Office facsimile number (571) 273-8300. Total number of pages in this transmission 10.

Date

01/24/2006

Gloria L. Knox

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

John R. Milton

Application No.: 09/938,466

Filed: August 23, 2001

Title: **SYSTEM AND METHOD FOR TRACKING PLACEMENT AND USAGE OF CONTENT IN A PUBLICATION**

Confirmation No.: 4080

Group Art Unit: 2162

Examiner: Corriellus, J.

Docket No. 10010979-1

PETITION FOR WITHDRAWAL OF HOLDING ABANDONMENT
FILED UNDER 37 C.F.R. §1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

1. Applicant petitions that the abandonment set forth in the notice mailed by the office on **December 23, 2005** be withdrawn.

2. Submitted herewith is:

- ☐ A copy of the page of the response mailed _____ showing a Certificate of Mailing executed on _____.
- ☐ A copy of the post card identifying the papers filed and showing the USPTO receipt stamp dated _____.
- ☐ A copy of the complete response previously filed.
- ☐ A copy of the attorney's Deposit Account Statement in which the item corresponding to the response referred to above is checked.
- ☒ A statement of facts as set forth in the 37 CFR 1.181(b).
- ☒ Declaration of Michael J. D'Aurelio in Support of the Petition for Withdrawal of Abandonment filed under 37 C.F.R. §1.181(a).

3. Please proceed with further examination of this application on the basis of:
- ☐ The original papers filed, which have now reached the appropriate area of the PTO;
 - ☐ The attached copy of the papers originally filed, and/or;
 - ☐ Other.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally, please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of Code of Federal Regulations that may regulate fees.

Respectfully submitted,



Michael J. D'Aurelio, Reg. No. 40,977

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

JAN 24 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|--------------------------------|---|-------------------------|
| In re the application of: |) | Confirmation: 4080 |
| John R. Milton |) | |
| Application Number: 09/938,465 |) | Art Unit: 2162 |
| Filing Date: 8/23/2001 |) | Examiner: Corrielus, J. |
| Title: SYSTEM AND METHOD FOR |) | Docket No.: 10010979-1 |
| TRACKING PLACEMENT AND |) | |
| USAGE OF CONTENT IN A |) | |
| PUBLICATION |) | |

**DECLARATION OF MICHAEL J. D'AURELIO IN SUPPORT OF THE PETITION FOR
WITHDRAWAL OF ABANDONMENT FILED UNDER 37 C.F.R. §1.181(a)**

I, Michael J. D'Aurelio hereby declare that:

1. I am a registered before the US Patent and Trademark Office ("USPTO") under registration number 40,977 and I am an attorney of record responsible for the prosecution of United States Patent Application 09/938,465.

2. On April 21, 2005, Examiner Jean M. Corrielus of the USPTO issued a Final Office Action in Application Number 09/938,465. This Final Office Action noted that claims 1-23 were pending in the application; claims 22 and 23 were allowed; claims 1-3, 5-10, 12-17, and 19-21 stood rejected; and claims 4, 11, and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. On May 25, 2005, within 2 months of the mailing date of the Final Office Action, I drafted and filed a Response to the Final Office Action in which the subject matter of claims 4, 11, and 18 was incorporated into independent claims 1, 8, and 15, thereby placing claims 1-21 in condition for allowance based upon the objection stated

by Examiner Corrielus to claims 4, 11, and 18. This Response put the Application in condition for allowance and did not introduce any new issues.

4. On June 13, 2005, Examiner Corrielus issued an Advisory Action in reply to Applicants Response of May 25, 2005. The Advisory Action stated that "the proposed amendments filed after the final, but prior to the date of filing a brief, will not be entered because they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal." In addition, the Advisory Action stated "NOTE: The amended claims fails to disclose the applicant invention. The amendment to the claims does place the application in condition for allowance."

5. The Advisory Action was incorrect in its reasoning for not entering the amendments since the amendments presented in the Response of May 25, 2005 actually placed the application in condition for allowance based upon the Final Office Action. This checked statement also contradicted the NOTE that stated that the amendment placed the application in condition for allowance. It was not clear to me whether the statement that "The amended claims fails to disclose the applicant invention" was a new ground of rejection, which is improper in an Advisory Action.

6. To resolve the confusion, I called Examiner Corrielus within a few days after receiving the Advisory Action to ask him about it. I stated at the time that if there was new ground of rejection, it was improper to present it in an Advisory Action and that a new Office Action should have been issued. Also, I inquired as to precisely what was meant by the sentence: "The amended claims fails to disclose the applicant invention."

7. Examiner Corrielus indicated he would review the Response of May 25th as he had misread it and did not realize that it placed the case in condition for allowance. He said he would issue a Notice of Allowance in due course.

8. On August 22, 2005, I had not received any subsequent action from the USPTO regarding this Application. Concerned that we were running out of time to forward another Response to the Office Action if necessary, I once again called Examiner Corrielus to determine the status of the case. He indicated that he had reopened prosecution in the case and had sent out a new Office Action which we would receive in due course. I informed our client, Hewlett-Packard Company that the new Office Action was forthcoming. Consequently, in reliance upon the statements by Examiner Corrielus, we resolved to take no further action in the case and waited to receive the new Office Action.

9. On December 23rd, Examiner Corrielus issued a Notice of Abandonment for the Patent Application. The Notice stated that the application was abandoned in view of "Applicant's failure to timely file a proper reply to the Office Letter mailed on April 18, 2005" and that "No reply has been received". This notice was issued despite the statements by Examiner Corrielus that a new Office Action was being issued in the case.

10. On January 18, 2006, I called Examiner Corrielus to find out why the Notice of Abandonment had been issued instead of a new Office Action as per our previous conversations. He indicated that he remembered our previous conversations and that he had intended to issue a new Office Action and expressed some surprise that a Notice of Abandonment had been sent in this case. He stated that it appeared he made a mistake in issuing the Notice of Abandonment and requested that I file a Petition to Withdraw the Holding of Abandonment so that he could issue a new Office Action in the case.

I hereby declare that all statements made herein are of our own knowledge are true and that all statements are made on information and belief and are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Michael J. D'Amelio

1/24/05
Date

JAN 24 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| John R. Milton |) | |
| Application Number: 09/938,465 |) | Art Unit: 2162 |
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| Title: SYSTEM AND METHOD FOR |) | Docket No.: 10010979-1 |
| TRACKING PLACEMENT AND |) | |
| USAGE OF CONTENT IN A |) | |
| PUBLICATION |) | |

**STATEMENT OF FACTS ACCOMPANYING PETITION FOR WITHDRAWAL OF
ABANDONMENT FILED UNDER 37 C.F.R. §1.181(a)**

On April 21, 2005, Examiner Jean M. Corrielus of the USPTO issued a Final Office Action in Application Number 09/938,465. This Final Office Action noted that claims 1-23 were pending in the application; claims 22 and 23 were allowed; claims 1-3, 5-10, 12-17, and 19-21 stood rejected; and claims 4, 11, and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response to the Final Office Action, on May 25, 2005, within 2 months of the mailing date of the Final Office Action, a Response was filed in which the subject matter of claims 4, 11, and 18 was incorporated into independent claims 1, 8, and 15, thereby placing claims 1-21 in condition for allowance based upon the objection stated by Examiner Corrielus to claims 4, 11, and 18. This Response put the Application in condition for allowance and did not introduce any new issues.

On June 13, 2005, Examiner Corrielus issued an Advisory Action in reply to Applicants Response of May 25, 2005. The Advisory Action stated that "the proposed amendments filed after the final, but prior to the date of filing a brief, will not be entered because they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal." In addition, the Advisory

Action stated "NOTE: The amended claims fails to disclose the applicant invention. The amendment to the claims does place the application in condition for allowance."

The Advisory Action was incorrect in its reasoning for not entering the amendments since the amendments presented in the Response of May 25, 2005 actually placed the application in condition for allowance based upon the Final Office Action. This checked statement also contradicted the NOTE that stated that the amendment placed the application in condition for allowance. It was not clear to me whether the statement that "The amended claims fails to disclose the applicant invention" was a new ground of rejection, which is improper in an Advisory Action.

To resolve the confusion, I called Examiner Corrielus within a few days after receiving the Advisory Action to ask him about it. I stated at the time that if there was a new ground of rejection, it was improper to present it in an Advisory Action and that a new Office Action should have been issued. Also, I inquired as to precisely what was meant by the sentence: "The amended claims fails to disclose the applicant invention."

Examiner Corrielus indicated he would review the Response of May 25th as he had misread it and did not realize that it placed the case in condition for allowance. He said he would Issue a Notice of Allowance in due course.

On August 22, 2005, I had not received any subsequent action from the USPTO regarding this Application. Concerned that we were running out of time to forward another Response to the Office Action if necessary, I once again called Examiner Corrielus to determine the status of the case. He indicated that he had reopened prosecution in the case and had sent out a new Office Action which we would receive in due course. I informed our client, Hewlett-Packard Company that the new Office Action was forthcoming. Consequently, in reliance upon the statements by Examiner Corrielus, we resolved to take no further action in the case and waited to receive the new Office Action.

On December 23rd, Examiner Corrielus issued a Notice of Abandonment for the Patent Application. The Notice stated that the application was abandoned in view of "Applicant's failure to timely file a proper reply to the Office Letter mailed on April 18, 2005" and that "No reply has been received". This notice was issued despite the

statements by Examiner Corrielus that a new Office Action was being issued in the case.

On January 18, 2006, I called Examiner Corrielus to find out why the Notice of Abandonment had been issued instead of a new Office Action as per our previous conversations. He indicated that he remembered our previous conversations and that he had intended to issue a new Office Action and expressed some surprise that a Notice of Abandonment had been sent in this case. He stated that it appeared he made a mistake in issuing the Notice of Abandonment and requested that I file a Petition to Withdraw the Holding of Abandonment so that he could issue a new Office Action in the case.

Thus, the Notice of Abandonment should be withdrawn as this case was never abandoned. Specifically, the Response to the Final Office Action filed on May 25, 2005 placed the Application in condition for allowance and was fully responsive to the rejections in the Final Office Action without introducing new issues for search. In this respect, the Advisory Action was improperly issued and the contention that the Response filed on May 25, 2005 could not be entered is without merit. In addition, Applicants took no further action in the case in reliance upon the statements of Examiner Corrielus over the telephone that a new Office Action would be issued in the case as it was clear that the Advisory Action was erroneously issued. Given that (1) Applicants had filed a proper Response after a Final Office Action placing the case in condition for allowance, (2) the Advisory Action was improperly issued in the case and that the Response should have been entered, and (3) the fact that Applicants relied upon express statements that a new Office Action would issue in the case, Applicants assert that the application was never abandoned and that the Holding of Abandonment was improperly issued. Accordingly, Applicants assert that the holding of Abandonment should be withdrawn and prosecution reopened in the application.

In support of the facts alleged herein, a Declaration of Michael J. D'Aurelio in Support of the Petition for Withdrawal of Abandonment accompanies this Statement of Facts alleging the pertinent facts discussed herein.

Respectfully submitted,



Michael J. D'Aurelio
Reg. No. 40,977

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